



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,700	02/16/2001	Robert M. Szabo	6169-156	4280
40987	7590	01/22/2008		
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188				
EXAMINER				
LASTRA, DANIEL				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
01/22/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/785,700

**Applicant(s)**

SZABO ET AL.

**Examiner**

DANIEL LASTRA

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) 1-13 and 16-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-13 and 16-24 have been examined. Application 09/785,700 (METHOD AND APPARATUS FOR STIMULATING COMMERCE) has a filing date 02/16/01.

#### ***Response to Amendment***

2. In response to Final Rejection filed 09/20/2007, the Applicant filed an RCE on 10/31/2007, which amended claims 1, 10 and 16.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-9, 16-18 and 20-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz (US 2001/0014868).

As per claims 1, Herz teaches:

A computer-implemented method of providing promotional material to consumers comprising:

generating in a merchant computer system a merchant request to stimulate commerce for merchant-specified products (see paragraph 246);

establishing a computer communications session between the merchant computer system and a third-party remote shopping stimulation system wherein the merchant request is conveyed to the third party shopping stimulation system (see paragraph 246) ;

reading with said third-party remote shopping simulation system consumer purchase information from a plurality of merchant computer systems, said consumer purchase information comprising consumer identifying information and product information (see paragraph 246);

based at least in part on said consumer purchase information, identifying one or more potential consumers who have previously purchased one or more of the merchant-specified products (see paragraphs 246 and 249 "previously purchased computer components");

determining *based upon predetermined product attributes irrespective of merchant inventories* that at least one of the merchant-specified products is an obsolete product (see paragraph 246 "computer system in need of upgrade") when a new or alternate version of the at least one of the merchant-specified products has at least one among current availability and expected availability within a predetermined time period (see paragraph 246 "upgrades to a computer"), and ascertaining which of said identified potential consumers previously purchased at least one of said obsolete products (see paragraphs 246 and 24 "elapsed time period to previous purchase");

in said third-party remote shopping stimulation system, generating promotional material for said new or alternate version of the at least one of the merchant-specified

products of the one or more potential customers ascertained as having previously purchased the at least one of said merchant-specified product identified as an obsolete product, and associating said promotional material corresponding to said new or alternate version of the at least one of the merchant-specified products with said ascertained consumers (see paragraphs 246 and 248 "offering a upgrade offer to a existing computer system previously purchased by a user") and

making said promotional material available to said identified consumers using a promotional material delivery system (see paragraph 246).

As per claims 2 and 17, Herz teaches:

said identifying step further comprising determining a product consumption rate from said consumer purchase information to identify said one or more potential consumers of the least one merchant-specified product (see paragraphs 298-299 "incorporating time in our price point analysis").

As per claim 3, Herz teaches:

wherein said promotional material and said consumer purchase information include person-to-person transactions and Internet-based transactions (see paragraphs 251 and 262).

As per claims 5 and 20, Herz teaches:

wherein said consumer purchase information is read from a purchase history database comprising consumer purchase information for a plurality of different merchants, and wherein the third-party remote shopping stimulation system responds to merchant requests from said plurality of different merchants (see paragraphs 21-22).

As per claims 6 and 21, Herz teaches:

wherein the one or more merchant-specified products comprise a service (see paragraph 4).

As per claims 7 and 22, Herz teaches:

said product information comprising product expiration information and product identifying information wherein said step of identifying one or more potential consumers of products is additionally based upon the expiration information of products (see paragraph 246 "need to upgrade a system").

As per claims 8 and 23, Herz teaches:

wherein said promotional material made available to said identified consumers is in electronic format (see paragraph 251).

As per claims 9 and 24, Herz teaches:

wherein said promotional material made available to said identified consumers is in printed format (see paragraph 21).

As per claim 16, Herz teaches:

A computer-implemented method of providing promotional material to consumers comprising:

establishing a computer communications session between a merchant computer system (see figure 1, items 131, 132) and a third-party remote shopping stimulation system (see figure 1, item 100);

reading with said third-party remote shopping stimulation system consumer purchase information from a plurality of merchant computer systems, said consumer purchase information comprising consumer identifying information and product information corresponding to merchant-specified products (see paragraph 246);

*determining based upon predetermined product attributes irrespective of merchant inventories* the at least one of the merchant-specified products is an obsolete product (i.e. "upgrade system" paragraph 246) when said at least one of said merchant specified products has at least one among a new or alternate version having current availability, a new or alternate version having expected availability within a predetermined time period, and a new or alternate version replacing said at least one of the merchant-specified products reaching an end of a product life cycle (see paragraph 246 "computer system needs to be upgraded"), and identifying at least one of the merchant-specified products as an obsolete product (see paragraph 248 "previously purchased computer components");

in response to determining that at least of the merchant-specified products is an obsolete product, identifying one or more potential consumers who previously

Art Unit: 3622

purchased the obsolete products based at least in part on said consumer purchase information (see paragraphs 246, 248 "identifying potential customer that previously purchase a computer system and components and need an upgrade");

in said third-party remote shopping stimulation system, generating promotional material for said new or alternative version of the identified obsolete product and associating said promotional material corresponding to new or alternative version of said identified obsolete product with said identified consumers (see paragraph 246); and

making said promotional material available to said identified consumers using a promotional material delivery system (see paragraph 246).

As per claim 18, Herz teaches:

wherein said promotional material and said consumer purchase information include person-to-person transactions and Internet-based transactions (see paragraphs 251 and 262).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 10-13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 2001/0014868) in view of Barenbaum (US 2001/0039514).

As per claims 4 and 19, Herz does not expressly teach:



wherein each said step is performed responsive to the merchant system detecting a business necessity corresponding to said new or alternate versions of said product identified as an obsolete product, wherein said business necessity corresponds to a merchant of said new or alternate versions of said product identified as an obsolete product having excess inventory of said new or alternate versions of said product identified as an obsolete product. However, Barenbaum teaches a system that detects over-stocked inventories and target offers to potential customers based upon said detection of over-stocked supply (see paragraph 18). Furthermore, Barenbaum teaches that said potential customers for said target offers are selected based upon said potential customers' previous purchases (see paragraph 35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Herz would target offers to potential customers based upon detection of an over-stocked inventory, as taught by Barenbaum in order to better control an inventory size, avoid a clog up situation in a merchant's back-room storage (see Herz paragraph 311) and also in order to try to sell products that are near to expire (i.e. "abundant supply of summer dresses and approaching the end of summer"; "over-stocked strawberries that will be worthless in a few days"; see Barenbaum paragraph 18).

As per claim 10, Herz teaches:

A system for providing promotional material to consumers comprising: a merchant computer system configured to generate a merchant request to stimulate commerce for one or more merchant-specified products;

a shopping stimulation logic unit in communication with said merchant inventory management system (see paragraph 311) for determining *based upon predetermined product attributes irrespective of merchant inventories* that at least one merchant-specified product is an obsolete product when a new or alternate version of the at least one merchant-specified product has at least one among current availability and expected availability within a predetermined time period (see paragraph 246 “upgrade components”), and identifying that at least one merchant-specified product as an obsolete product (see paragraphs 246 and 248 “particular upgrades to a computer system”);

a promotional information database, accessible by said shopping stimulation logic unit, and comprising consumer identifying information identifying one or more potential consumers who have previously purchased the at least one merchant-specified product identified as an obsolete product (see paragraph 248 “previously purchase software features”) and

a promotional material delivery system configured to generate promotional material for the one or more potential customers identified as having previously purchased the at least one merchant-specified product identified as an obsolete product and to make said promotional material available to said identified consumers (see paragraphs 246 and 248 “sending offers to upgrade a system based upon previously purchase features”).

Herz does not expressly teach a merchant inventory management system configured to track shipments received by one or more merchants of the one or more

merchant-specified products. However, Barenbaum teaches a system that detects over-stocked inventories and target offers to potential customers based upon said detection of over-stocked supply (see paragraph 18). Furthermore, Barenbaum teaches that said potential customers for said target offers are selected based upon said potential customers' previous purchases (see paragraph 35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Herz would target offers to potential customers based upon detection of an over-stocked inventory, as taught by Barenbaum in order to better control an inventory size, avoid a clog up situation in a merchant's back-room storage (see Herz paragraph 311) and also in order to try to sell products that are near to expire (i.e. "abundant supply of summer dresses and approaching the end of summer"; "over-stocked strawberries that will be worthless in a few days"; see Barenbaum paragraph 18).

As per claim 11, Herz teaches:

a consumer purchase information data structure for storing consumer identifying information and product information corresponding to a purchase transaction (see figure 1, item 124 "shopper history database").

As per claim 12, Herz teaches:

a commerce system for collecting said consumer purchase information in a computer communications network environment (see figure 1).

As per claim 13, Herz teaches:

wherein said promotional material and said consumer purchase information include person-to-person transactions and Internet-based transactions (see paragraphs 251 and 262).

### **Response to Arguments**

5. Applicant's arguments with respect to claims 1-13 and 16-24 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Primary Examiner, Art Unit 3622  
January 17, 2008